



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/705,757 Confirmation No. : 4848
First Named Inventor : Eberhard WEIHE
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TC/A.U. : 1636
Examiner : Jennifer A. Dunston

Docket No. : 029310.52818US
Customer No. : 23911

Title : Screening Method Using Pim1-Kinase or Pim3-Kinase

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY

Sir:

This Reply is filed in response to the Restriction Requirement mailed by the Patent and Trademark Office on July 14, 2005. The Restriction Requirement indicates that claims 1-30 are separated into eight groups. In response to that requirement, Applicants elect Group I, including claims 1-15, 32-34 and 47, for prosecution in this application. Claim 47 is further restricted into three groups, as claim 47 depends from claim 36 which recites the members of the three groups. In response to that requirement, Applicants provisionally elect Group 1 (the polynucleotides and cells of claim 36[a-c, f(a-d)]), this election being made with traverse, as explained below. At least claims 1, 5, 13 and 32-34 are further restricted into three groups. In response to that requirement, Applicants provisionally elect Group i, PIM-1 kinase, this election being made with traverse, as explained below. The nucleic acid and amino acid sequences relating to the PIM-1 kinase include at least SEQ ID NOS 1-6.

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The Restriction of claim 47 into Group 1-3 is respectfully traversed. Claim 47 is directed to a method where a test substance is incubated with an active ingredient and measurement of binding or a functional parameter is made. The steps of the method of claim 47 do not change depending on which active ingredient is used. Accordingly, examining claim 47 for the full breadth of the active ingredients recited in claim 36 does not present any undue burden or excessive search requirement. Claim 47 should be examined over the full scope of the active ingredients recited in claim 36. Reconsideration and withdrawal of this requirement are respectfully requested.

The Restriction of claims among Groups i-iii, directed to different kinases, is respectfully traversed. Such a requirement is improper because it fails to comply with the provisions of M.P.E.P. §803.02 set forth as follows:

[I]t is improper for the Office to refuse to examine that which the applicants regard as their invention, unless the subject matter in a claim lacks unity of invention.... Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

All of the compounds included share a common utility. Each of the kinases, PIM1-kinase, PIM2-kinase or PIM3-kinase shares similar binding activity. Accordingly, the kinases share a common use. Because binding activity is largely a product of physical structure, similarities in binding activity are commonly attributed to similarities of structure. Accordingly, these proteins likely share a common structural feature and this common structural feature gives rise to the common binding activity (utility) of the proteins. Reconsideration and withdrawal of this requirement are respectfully requested.

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If there are any questions regarding this response or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

Although a petition for a one month extension of time is submitted herewith, if necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response; please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Attorney Docket No. 029310.52818US).

Respectfully submitted,

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